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| EXAMINER | |
|---|---|
| LEROUX, ETIENNE PIERRE | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2161 | |

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/087,204 | WANG ET AL. | |
| | Examiner | Art Unit | |
| | Etienne P LeRoux | 2161 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.



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### *Claim Status:*

Claims 1-18 are pending. Claims 1-18 are rejected in this first examination on the merits.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 9, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 8 and 17 recite "wherein the media includes a file stored on a memory device of the user's personal computer." The skilled artisan would not know how to make and user the invention because the specification does not provide a clear and concise description of the manner and process of making a media file which is stored in the memory of a user's personal computer. The specification of the present application discloses extracting raw parameter data from a CD in the drive of a user's CD player and the extraction of raw parameter data from streaming audio. Furthermore, the specification in paragraph 6 states that no copy of the original file is created not even on a temporary basis. One of ordinary skill in the art would not know how to use the present invention such that raw parameter data is extracted from a user's hard drive.

Claims 9 and 18 are similarly rejected for including language of like nature to claims 8 and 17.

***Art Rejection Precluded***

Claims 8, 9, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicant's arguments regarding lack of enablement provided in applicant's response of 12/29/2004 were carefully considered but were not persuasive. The above rejection is thus maintained under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. No art rejection of claims 8, 9, 17 and 18 is provided in this final office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 6,061,680 issued to Scherf (hereafter Scherf).

Claims 1 and 10:

Scherf discloses:

- extracting a plurality of parameters from a media including a known media sample during a playing of the media by a user [number and length of tracks, col 5, lines 44-55];

- transmitting the plurality of parameters to a predetermined server [Fig 1 server] on a communication network [Fig 1 HTTP connection], which predetermined server is coupled to a recognition database [Fig 1, server database];

- storing the plurality of parameters in the recognition database along with an identity of the known media sample [col 6, lines 21-25];

- processing the plurality of parameters into a plurality of fingerprints/landmarks [unique identifier, col 5, lines 45-55] used in a recognition process.

Claims 2 and 11:

Scherf discloses sending, simultaneously with transmitting the plurality of parameters to the server, metadata [unique identifier, col 5, lines 45-55] used to identify the media sample to a second predetermined server; and forwarding a resulting identification to the server coupled to the recognition database.

Claims 3 and 12:

Scherf discloses returning the resulting identification to the user and then uploading the resulting identification with transmitting of the plurality of parameters [col 6, lines 45-50]

Claims 4 and 13:

Scherf discloses wherein the resulting identification is forwarded directly to the first predetermined server coupled to the recognition database [col 6, lines 33-38].

Claims 5 and 14:

Scherf discloses performing a check prior to extracting the plurality of parameters to determine whether the recognition database currently holds a latest version of the media sample before extracting the plurality of parameters [col 6, lines 11-20].

Claims 6 and 15:

Scherf discloses wherein the media includes a compact disk or digital video disk that is played on the user's personal computer [col 5, lines 44-47].

Claims 7 and 16:

Scherf discloses the media includes a streaming media sample being played on the user's personal computer [col 4, lines 35-38].

***Response to Arguments***

Applicant's arguments filed 12/29/2004 have been fully considered but they are not persuasive.

**Applicant Argues:**

Applicant maintains that claims 8, 9, 17 and 18 comply with the enablement requirement under 35 U.S.C. 1112, first paragraph. Applicant points to the specification of the present application which discloses in paragraph 28 "In a similar fashion, one could extract raw parameters using the same process-flows as described from scanning a user's hard drive or tapping into streaming music."

**Examiner Responds:**

Examiner is not persuaded. The specification of present application states in paragraph 6 that "no copy of the original file is created, even temporarily in the process of the present invention." As no temporary copy of the original file is created, one of ordinary skill in the art would not know how to make and use the invention because the invention is drawn to parameter extraction from a CD in the drive of a user's CD player or to parameter extraction from a streaming media sample being played on the user's personal computer (claim 7). The specification does not contain a clear and concise description regarding the manner of extracting parameters by scanning a user's hard drive such that a skilled artisan can make and use the invention. The statement in the specification "In a similar fashion" is not sufficient to enable a skilled artisan to make and use the invention.

**Applicant Argues:**

Applicant states in the second paragraph on page 8 "As further evidence of the lack of anticipation of the claims at issue, Scherf is cited by the Applicant in the background section of the present application.

**Examiner Responds:**

Examiner is not persuaded. Applicant states that Scherf is cited in the background of the pending application and therefore, for some unexplained reason, Scherf does not anticipate. Examiner is not persuaded that the citation in the background of the invention is a per se basis to state a reference does not anticipate. In fact "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2

USPQ2d 1051, 1053 (Fed. Cir. 1987). In supra office action, examiner has mapped the elements of the claimed invention to the cited prior art and thus based on supra evidence, examiner maintains Scherf anticipates the claimed invention.

**Applicant Argues:**

Applicant states in the second paragraph on page 8, "Moreover, Scherf uses track length and number of tracks to uniquely identify a given compact disk – not a media sample – but rather a media with many tracks. In contrast the present invention employs a media recognition system to identify a sample of a media (eg., portion of a song).

**Examiner Responds:**

Examiner is not persuaded. Examiner points out that the notion of a "portion" of a song does not distinguish between a portion of a media track that contains, for example, a single block of data to the entire song. In fact, Scherf, relies on reading enough of the CD track in order to extract metadata (col. 5, lns. 45-55), which reads on "a portion of a song" and therefore a media sample as defined by applicant.

**Applicant Argues:**

Applicant states in the second paragraph on page 8, "To enable rapid creation of this database, the present invention utilizes third party playing of music to generate raw parameters, which are transmitted to a server and which are then processed into the necessary fingerprint/landmarks used in the recognition process. These raw parameters are not the same as

the information used by Scherf, as the information used by Scherf cannot be further processed to be used to identify a media sample.

**Examiner Responds:**

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., raw parameters) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Scherf discloses the following in col 5, lines 45-55:

> A further aspect of the invention is the ability, by making use of the command plug-in, to provide a technique for establishing a **unique identifier for an audio CD which is located in the user's CD player**. The unique identifier may be based on the number and lengths of the tracks (measured in blocks, i.e., 1/75ths of a second), so that the identifier would be a concatenation of these lengths. In practice, however, it is desirable to have a somewhat shorter identifier, so the unique identifier is preferably the concatenation of the track lengths expressed in a fairly coarse unit, such as 1/4th of a second.

Based on the above disclosure, examiner maintains that Scherf anticipates the claim limitation "processing the plurality of parameters into a plurality of fingerprints/landmarks used in a recognition process."

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

4/2/2005

SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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